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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,243	02/06/2002	Bryan Spiess	A490-003	8499
Mi Kim 59 Marial Rose Dr. Portsmouth, RI 02871	7590 03/27/2008		EXAMINER AFZAL, SARANG	
			ART UNIT 3726	PAPER NUMBER
			MAIL DATE 03/27/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/068,243

**Applicant(s)**

SPIESS, BRYAN

**Examiner**

SARANG AFZALI

**Art Unit**

3726

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-33 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-27 and 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9/18/2007 has been entered.

### ***Election/Restrictions***

2. Applicant's election with traverse of Group I, claims 14-27 and 30-33 in the reply filed on 3/3/2008 is acknowledged, however, there is no ground(s) for the Applicant's traversal.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

3. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what exactly the limitation "roller is a single piece component" is referring to. Applicant's disclosure, including Figure 1, identifies

element 10 as a roller made of a plurality of pieces/components (12, 14, 16 and 20). It is unclear how the roller 10 can be made of a single piece component.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 14-16, 18-25, 27, and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson et al. (US 4,203,509).

As applied to claims 14-16, Thompson et al. teach an aircraft roller system (col. 1, line 6) comprising:

- (a) a single piece cylindrical body (17, Fig. 1), said body having a length and a diameter; and
- (b) an aperture extending longitudinally along and through the center of said body, wherein said body consists essentially of a polymer (col. 2, lines 12-15 and col. 3, lines 21-30, "super-tough nylon").

As applied to claim 18, Thompson et al. teach that the ends of the roller (10) are shaped to provide a shoulder (the area where element 18 encroaches into element 17, Fig. 1).

As applied to claims 19-22, Thompson et al. teach the invention cited including the physical properties of the polymeric material.

Regarding the limitations "impact strength of at least 0.5 (ft. lbs./inch)", "flexural strength of at least 20 psi", "compressibility strength of at least 20 psi and 200 psi", it is noted that Thompson et al. inherently teaches these physical properties. Thompson et al. teach that the polymer used in the roller is made from "nylon" (see col. 2, lines 12-15 and col. 3, lines 21-30). On page 5, second full paragraph of applicant's specification, applicant describes that suitable polymers include nylon among with other polymers. Therefore, since both the prior art and the applicant uses "nylon", it is inherent that Thompson et al. inherently teaches the claimed physical properties of the polymer. Applicant has not provided the physical properties of each of the polymer materials described in the specification at page 5, second full paragraph, therefore, it is understood that all of the described polymer materials on page 5, second full paragraph of applicant's specification meet the claimed "impact strength of at least 0.5 (ft. lbs.)/inch, a flexural strength of at least 20 psi, and a compressibility strength of at least 20 psi & 200 psi", with "nylon" as taught by Thompson et al. being among the polymer materials. Therefore, Thompson et al. also inherently teach the limitations of claims 19-22.

As applied to claims 23-25, Thompson et al. teach the invention cited including the claimed ranges for the length and diameter for the body of the roller (col. 3, lines 15-19).

As applied to claim 27, Thompson et al. teach the invention cited including the roller used in an aircraft conveyor system (use in multiple to establish a light-weight high-strength roller floor for cargo-carrying aircraft, col. 1, lines 4-6).

As applied to claims 30-32, note that the Applicant is claiming a product in a product-by-process claim (a roller made by steps a-c) and as such, the patentability of product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citing *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969)). If a product in a product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product is made by a different process. *Id.* citing *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F. Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

The instant invention is not directed to a method of making the roller, but to the roller itself which is a product. The final product is structurally the same as Thompson et al. as discussed in rejection of claims 14 and 16, above.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17, 26 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (US 4,203,509).

As applied to claim 17, Thompson et al. teach the invention cited with the exception of using the claimed acetyl copolymer.

At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have used the claimed polymer because applicant has not disclosed that the claimed polymers provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally as well with the nylon polymer taught by Thompson et al. or acetyl copolymer as claimed, because either type of polymer perform the same function of providing a roller surface that has the desired compressibility and strength. Furthermore, in applicant's specification, at page 5, lines 8-13, there is a listing of different polymers and all are suitable for the rollers. There is no indication that one polymer is better than another.

As applied to claim 26, Thompson et al. teach the invention cited with the exception of the claimed length of the roller body.

At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have used the claimed length for the roller body because applicant has not disclosed that the claimed length provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally as well with the roller body length taught by Thompson et al. or roller body length as claimed, because either length of the roller body performs the same function of providing a desired roller surface for holding and carrying loads. Furthermore, in

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applicant's specification, at page 4, lines 17-21, there is a listing of different lengths suitable for the rollers. There is no indication that one certain length is better than another.

As applied to claim 33, note that the Applicant is claiming a product in a product-by-process claim (a roller made of acetyl copolymer made by steps a-c of claim 30) and as such, the patentability of product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citing *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969)). If a product in a product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product is made by a different process. *Id.* citing *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F. Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

The instant invention is not directed to a method of making the roller, but to the roller itself which is a product. The final product is structurally the same as Thompson et al. as discussed in rejection of claim 17, above.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARANG AFZALI whose telephone number is (571)272-8412. The examiner can normally be reached on 7:00-3:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sarang Afzali/  
Examiner, Art Unit 3726  
3/21/2008

/David P. Bryant/  
Supervisory Patent Examiner, Art Unit 3726